

RESPONSE

Item 1. The examiner's challenge to Applicants' claim of priority to SN 09/215,915 is acknowledged. At no point in the history of the present application, and the earlier cases to which the present application claim's priority, did Applicants claim priority to SN 09/215,915. Applicants' are not aware of this application and do not know the substance of this application. Thus, Applicants' request a copy of application S/N 09/215,915. It is Applicants' right to have a copy of this application, because it has been cited by the Examiner in an office action.

The Examiner's reference to item 8 of Applicants' September 30, 2002 Response is misplaced.¹ Item 8 was directed toward a very specific objection in the Examiner's March 27, 2002 Office Action. It was not directed to the general claim of priority to the various parent applications. To the contrary item 2 of Applicants' September 30, 2002 Response was directed toward and fully answered the Examiner's general inquiries about Applicants' priority claim. The Examiner has not disputed Applicants' positions as set forth in Item 2 of Applicants' September 30, 2002 Response.

As such, the Examiners present challenge to Applicants' claim of priority is totally without merit and it is respectfully requested that the Examiner withdraw such challenge. Moreover, the Examiner's present challenge to Applicants' claim

¹ The Office Action refers to a September 3, 2002 communication. Applicants are not aware of such a communication. Applicants filed an Amendment and Response on September 26, 2002, that was received on September 30, 2002. This Amendment and Response will be referred to herein as "Applicants' September 30, 2002 Response".

of priority is an entirely new matter that has never before been raised and, as such, is not proper in a final rejection.

Additionally, each of the three parent applications to which Applicants claim priority is expressly incorporated by reference into the disclosure of the present application. Moreover, the parent applications expressly incorporate the disclosures of each other into themselves. Thus, parent application SN/09/215,865 (filed 12/18/98; lawyer docket no. 659/487) expressly incorporates parent application SN 09/215,866 (filed 12/18/98; lawyer docket no. 659/482) and parent application SN 09/215,951 (filed 12.18/98; lawyer docket no. 659/489) by reference at page 3, lines 5-15 (attached hereto as Exhibit 1). Similarly, parent application SN 09/215,866 (filed 12/18/98; lawyer docket no. 659/482) expressly incorporated application SN 09/215,951, (filed 12/18/98; lawyer docket no. 659/489) by reference at page 12, lines 6-9 (attached hereto as Exhibit 2).

Thus, all three parent applications stand on equal footing and Applicants are entitled to claim the benefit of prior to all three of them. *See Ex Parte Maziere*, 27 U.S.P.Q.2d 1705, 1706-07 (Bd. Pat. App. & Int. 1993)(Rejecting an Examiner's argument that was very similar to the position taken in the present Office Action).

Item 2. Applicants submit herewith (as Exhibit 3) a copy of the Submission of Corrected Drawings (Figures 1A and 3), which have been filed contemporaneous with the Patent Office. The requirement in the office Action for Applicants to submit "[a] proper drawing correction or corrected drawings" for the approved

changes to Figures 1A and 3 was made prior to the changes to the Rules. The new Rules do not appear to address this situation presented here. Thus, Applicants' have followed the express requirements of the Examiner.

Item 3. The Examiner's objection to the amendment to Figure 2 shows a fundamental misunderstanding of Applicants' invention, the disclosure in Applicants' specification and Item 4 of Applicants' September 30, 2002 Response. A separate patch of material to serve as a landing member is not part of the embodiment shown in Figure 2. Thus, the closure mechanism of Figure 2 works without the need for a separate patch of material, *i.e.*, the patch of material shown as number 5 in Figure 1D is not needed nor intended to be in Figure 2. Moreover, support for the drawing of Figure 2, without a separate patch of material, is expressly found at page 4, line 2 of the specification, which provides: "[a]lternatively, an outer member may serve as the fastening panel."

Thus, contrary to the Examiner's assertion, a drawing of Figure 2 is not required or intended to have a "separate square like that shown in Figure 1B." Such a separate square is not needed for the closure mechanism to function. The reference to the front section of Figure 2 as a "fastening panel 51" (as set forth at page 29 of the specification as amended) is proper and describes an appropriate closure mechanism. Accordingly, amended Figure 2, which does not show a separate patch of material, is correct as drawn.

The Examiner has no right or authority to make Applicants recast the description of their invention to meet the Examiner's views of that invention.

Applicants are the inventors here, not the Examiner. Thus, Applicants request that the objection to Figure 2 as amended be withdrawn.

Item 4. Applicants attorney has reviewed Title 35 of the United States Code and Title 37 of the Code of the Federal Register and can find no legal basis for the Examiner's assertion that the use of capitalization in conjunction with an "®" is improper. The Examiner points to no such authority.

Moreover, in the March 27, 2002 Office Action, the Examiner objected to Applicants' use of the term "Velcro ®" requiring that "**[i]t should be capitalized wherever it appears . . .**" (Page 2-3 of March 27, 2002 Office Action (bold added)). Applicants having complied with this express instructions of the Examiner are now faced with an objection for following those express instructions. Such an objection is unfair and improper. Moreover, as this objection has never been raised before it cannot form the basis for a final rejection.

Applicants' use of capitalization and the ®, fully meets the requirements of the MPEP, which provide that:

Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) **Every effort should be made** to prevent their use in any manner which might adversely affect their validity as trademarks. MPEP § 608.01(v)(emphasis added).

Applicants' use of capitalization and the trademark symbol clearly is the use of "every effort" to protect these marks. It is appropriate, it was required by the Examiner in the March 27, 2002 Office Action, and there is no legal or statutory basis under which the Examiner can maintain an objection to it.

Item 5. The Examiner provides no basis for the objection that "1) The Summary of the Invention Section, i.e., a description of the claimed invention, the invention as claimed, i.e., claims 1-8 and 10-14 are still not commensurate, . . ." (Office Action page 4). The Examiner, having provided Applicants' with no basis for this objection, has left Applicants to speculate as to that basis in order to respond. Such speculation is entirely improper and unfair. It could give rise to a prosecution history estoppel where none should occur. Moreover, requiring Applicants to guess at the basis for a final rejection (it is noted that the Examiner also failed to provide any basis for this rejection in the March 27, 2002 Office Action) is entirely improper and unfair. As such, Applicants respond to the objection that the summary of the invention section of the application as amended meets all the requirements of Title 35 of the United States Code and Title 37 of the Code of the Federal Register. Accordingly the Examiner's baseless objection should be withdrawn.

The Examiners' assertion that "2) Different numerals 5 and 51 are now used to describe the same structure, i.e., the front end fastener, i.e., a square like that shown in Figure 1B labeled 5 should be shown in Figure 2 and the description thereof on page 29 amended accordingly" has no basis in fact and evidences a fundamental misunderstanding of Applicants' specification, invention and the technology at issue. As set forth in detail in Item 3 above, a separate patch of material is not intended or needed in Figure 2. As such, the Examiner's objection should be withdrawn.

The Examiner's assertion that: "3) Page 2, lines 2-3 and second full paragraph and claims 4-5 and 7-8 don't set forth an upper limit of about 1500g or about 250g while page 19, lines 11-18 does. A clear consistent description of the limits should be set forth" provides no basis for the Examiner's objection. In fact, it can not be ascertained from the Office Action what statutory provision forms a basis for the Examiner's assertion. The Examiner's assertion appears to be based upon the Examiner's lack of understanding of this technology, Applicant's claimed invention and Applicant's specification. As with the Examiner's position on Figure 2, it appears to be no more than the Examiner casting herself in the role of inventor and attempting to require Applicants to rewrite their invention to meet her misguided view of it. Such a position by the Examiner is highly improper and unfounded.

Moreover, it could have the potential to substantially prejudice Applicants by creating a prosecution history estoppel where none should arise. Accordingly, it is noted for the public record that Applicants' arguments herein are in no way a representation as to the scope of Applicants' claims and are not the abandonment of any protection available under those claims. Applicants request that this assertion by the Examiner be withdrawn.

Item 6. Applicants have corrected the informalities in claim 1, 12 and 14 as required by the Examiner. Applicants note for the public record that the correction of these informalities does not limit, narrow or reduce the scope of protection to be afforded these claims.

Item 7. No response required

Item 8. Swenson EP 0703 068 A2 ("Swenson") does not anticipate claims 1-9. The Examiner ignores the fundamental rule that an anticipation analysis must be based upon the claims. Thus, in performing such an analysis the arrangement of all the claim elements must be considered in the manner in which they are arranged by the claim, *i.e.*, the claim must be considered as a whole. No where in the present rejection of claims 1-9 is there provided an analysis by the Examiner showing that each and every claim element is present in Swenson. It is submitted that no such analysis was made because Swenson does not anticipate these claims. No where in the Examiner's rejection of claims 1-9 is there provided a basis for the Examiner's assertion that "Swenson includes all the claimed structure." Applicants' are simply left to guess about the basis for this unsupported assertion by the Examiner.

"Anticipation under Section 102 requires 'the presence in a single prior art reference of all elements of a claimed invention arranged as in that claim.'" *Corella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986). Thus, it is impermissible to pick and choose and rearrange the elements found in a single prior art reference to find anticipation. See *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1369 (Fed. Cir. 2000) ("The district court clearly erred by misconstruing [within the reference] Figure 10's relationship to the text of the article."); *Aero Indus. Inc. v. John Donovan Enter.-Florida Inc.*, 53 U.S.P.Q.2d 1547, 1555-56 (S.D. Ind. 1999).

Swenson does not disclose all elements of claims 1-2 arranged as in those claims. Swenson does not disclose or suggest the front end fastener of these claims. The present Office Action ignores this claim element, impliedly

conceding its absence from Swenson's disclosure. The absence of this claim element from Swenson establishes that it can not anticipate claims 1-2. The present Office Action's failure to address this claim element, and its uncontested absence from Swenson, establishes the impropriety of the present rejection of these claims.

Moreover, the Examiner's reliance on the doctrine of inherence is misplaced and is incorrect under the controlling law. It appears that the Examiner has turned to the doctrine of inherency to support her assertion that Swenson discloses the element of claims 1-9 requiring that the width of at least one of the elastic panels being such that the panel when stretched can encircle the pant when used. By relying on the doctrine of inherency the examiner has conceded that this claim element is not literally present in the Swenson disclosure. In addition to not being literally present, Swenson, in fact teaches away from the use of this element. Specifically, with respect to the Figures relied upon by the examiner to support her inherency argument Swenson advises that the size of the panels in these Figures is "enlarged to show detail." (page 7, line 45; page 8 line 3). Thus, Swenson does not inherently disclose panels that are large enough to meet the claim element requiring the panel to be capable of encircling the pant when used. If anything flows from this disclosure of Swenson, it would be that the panels shown in those Figures are substantially smaller than the Figures and that these substantially smaller panels would inherently not meet this claim element. Regardless, this disclosure of Swenson is too vague and indefinite to form a proper basis for an inherency rejection.

Applicants further note that the Examiner has not provided the rationale or evidence required to support the assertion that Swanson inherently discloses all of Applicants' claim elements. As noted in MPEP 2112, with reference to *In re Robertson*, 169 F.39 743, 745 (Fed. Cir. 1999):

'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'
[emphasis added]

As the Examiner has not provided any rationale or evidence beyond a conclusory statement of inherency, a *prima facie* case of anticipation has not been made. This law is well established:

Words in a reference are to be construed in light of the relevant surroundings circumstances in each case, 'citation omitted], and a reference in any event is good only for that which it clearly and definitely discloses, [citation omitted]. Moreover, if we accept arguendo the board's position that Link can be alternatively interpreted to show either of two final core structures, then Link becomes an ambiguous reference which will not support an anticipation rejections *In re Hughes*, 145 U.S.P.Q. 467, 471 (CCPA 1965)

If a reference is ambiguous and can be interpreted so that it may or may not constitute an anticipation of an appellant's claims, and anticipation rejection under 102 based upon the ambiguous reference is improper. *In re Brink*, 419 F.2d 914, 917 (CCPA 1970)

The present Office Action cannot be reconciled with this law. In addition, the Examiner ignores the element of claims 3-9 that calls for the formation of a disposable pouch. This is a separate and distinct claim element from the panel size element. Its absence from Swenson, and from the Examiner's analysis, establishes that these claims are patentable over Swenson.

The Examiners statement that “[i]t is noted that the claims do not require folding or fastenability of panels prior to disposal” is inaccurate. Claims 3-9 all require that the panel fasten to itself when used. The Examiner’s statement can not be reconciled with this claim element.

The Examiner’s assertions regarding claim 3 are noted, but not understood. To the extent that the Examiner is relying upon the “the enlarged to show detail” figures of Swenson to support an inherency argument about the size and shape of Swenson’s panels, it is improper.

Accordingly, as set forth above the Examiner has failed to establish that Swenson anticipates claims 1-9.

Item 9. The Examiners’ 102(b) rejection of claims 10-14 is incomprehensible. As such, it is improper and should be withdrawn. It appears that the Examiner is making a 102(b) rejection of these claims based upon Sageser U.S. Pat. No. 5,454,803 (hereinafter “Sageser”). The Examiner, however, fails to site to any portion of Sageser to support her assertion that Sageser anticipates claims 10-14. From even a quick review of Sageser it is apparent that Sageser does not disclose each and every claim element as arranged in those claims and, as such, does not anticipate claims 10-14.

Instead of citing to Sageser, the Examiner cites to two other references, Buell and Scripps, to support her assertion that Sageser anticipates claims 10-14. Thus, it appears that the Examiner is combining Sageser, Buell and Scripps as the basis for her 102(b) rejection. This is not the law and is highly improper. One cannot combine *three separate references* to form the basis for a rejection

under 102(b). In fact, the Examiner's attempt to combine these references illustrates the failings of these references. None of these references alone discloses all elements of claims 10-14 arranged as in these claims. *Corella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986).

The Examiner's reference to "substantially the same" with respect to claims 10-14 is in error. First, that claim limitation is not present in claims 12-14 and as such the Examiner's statement should be withdrawn with respect to those claims. Second, although present in claims 10 and 11, that limitation is but one of several elements found in that claim. The Examiner, however, fails to establish that any of these other elements of claim 10 and 11 are disclosed by Sageser. For example, Sageser does not disclose elastic panels that are each long enough to surround the product when used and fasten to itself, thereby forming an elastic disposable pouch, as called for by the claim 10 as well as by claims 11-14. The side panels in Sageser are far too short to each (individually) surround the entire product as called for by the claims. As such, Sageser cannot anticipate claims 10-14.

The Examiner's reference to "the minimum amount of stretch using the elastic side panels is at least about 50%", (Office Action page 6(emphasis original)) is incomprehensible. It has no relationship to claims 10-14 or to the alleged anticipatory reference, Sageser, which the Examiner is relying upon. This "50% minimum amount of stretch" limitation is also not an element of claims 10-14. This limitation is not found in Sageser. As such, there is no basis for the

statement to have been made in the Examiner's 102(b) rejection of claims 10-14 over Sageser. Accordingly it should be withdrawn.

The Examiner's reference to inherency and claims 1-9 to support an apparent inherency rejection of claims 10-14, is similarly incompressible. Moreover, to the extent that it can be understood it is erroneous under the law and facts before the Examiner. Claims 10-14 do not contain the same limitations as claims 1-9. Thus, the Examiner's "repeat[ing]" her remarks from claim 1-9 as the basis for her inherency rejection of claims 10-14 cannot support the rejection of claims 10-14. Moreover, Applicants' are left to guess at what elements of claims 10-14 the Examiner believes to be inherently disclosed by Sageser (or the Examiner's improper combination of Sageser, Buell and Scripps). Forcing Applicants into such a guessing game is improper and unfair. Additionally, the legal errors of the Examiner's inherency rejection of claims 1-9 have been addressed above. As such, the inherency rejection of claims 10-14 should be withdrawn.

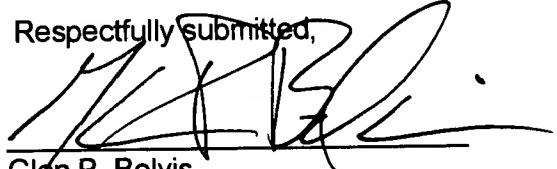
Item 10. No response required.

Item 11. The Examiner's inherency-obviousness rejection of claims 4-5 and 7-8 shows a similar misunderstanding of the law and the facts. The Examiner's blending of the doctrines of inherency and obviousness has been expressly rejected and strongly criticized by the Federal Circuit. *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81, 88 (Fed. Cir. 1986) (Inherence and obviousness are distinct concepts.) This improper blending of these two doctrines by the Examiner further illustrates the fundamental misunderstanding of the patent law

that has permeated the present Office Action. Moreover, the Examiner fails to provide any basis for her combination of Swenson and Sosalla. As such, the Examiner has engaged in no more than an improper hindsight reconstruction. Additionally, the Examiner ignores the remaining limitation of claims 4-5 and 7-8, which limitation are not present even under the examiner hindsight combination of Swenson and Sosalla. As such, the Examiner's inherency-obviousness rejection of claims 4-5 and 7-8 should be withdrawn.

Item 12. To the extent that responses are required to statements made in this item of the Office Action they have been made above.

Respectfully submitted,



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